181 (2)

No. 10-862

In The
Supreme Court of the United States

GREGORY W. BARAN,

Petitioner,

v.

MEDICAL DEVICE TECHNOLOGIES, INC.,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether 35 U.S.C. § 112, ¶ 6, which states that "an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof. . . . ," limits the specified function to only that which follows the words "means for," while ignoring other functions expressed in the claim.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rule 29.6, Medical Device Technologies, Inc. d/b/a Angiotech states that Angiotech Pharmaceuticals is the only corporation that holds ten percent (10%) or more of its stock.

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INTRODUCTION

The courts below construed the limitation "a release means for retaining the guide in a charged position" as "a means-plus-function claim in which the function is 'retaining the guide in the charged position and releasing, or setting free the guide from the charged position'." Pet. App. E at 79a (quoting *Markman* Op. at 50). There is no compelling reason to find fault with this rather straightforward claim construction. Petitioner, Gregory W. Baran, nonetheless protests that the function of releasing "is not specified in the means clause," meaning it does not follow the word "means," even though the function is literally expressed in the limitation. His complaint, however, does not identify a catastrophic departure from established principles of claim interpretation. In adopting the district court's construction, the Federal Circuit did not override 35 U.S.C. § 112, ¶ 6, "by adding that unrecited function to the function that *is* specified." Pet. at 11. There is no rigid rule of patent claim construction under 35 U.S.C. § 112, ¶ 6 that excludes from consideration any expressed function in the claim other than the one immediately following the word "means." There is no support in the plain language of 35 U.S.C. § 112, ¶ 6 or common sense that urges this Court to adopt such a rule based upon rigid syntax. Accordingly, there is no compelling reason for this Court to grant Baran's Petition.

STATEMENT OF THE CASE

I. The Claimed Invention

The claimed devices are biopsy needles comprised of stationary stylets disposed inside of sliding cannulas. Pet. App. C at 6a-7a. The sliding cannulas are attached to guides, which are designed to be pulled back against a coil spring until they become locked in a "charged" position. Pet. App. C at 6a-7a. The locking function is performed by a device that U.S. Patent No. 5,025,797 (the "'797 Patent") calls a "release lever" and occurs when the lever is moved such that a latching projection of the release lever engages a shoulder of the guide. Pet. App. C at 7a. (lever shown as 22 in Fig. 4); Pet. at 4. Pressing the other end of the lever releases the lock and allows the spring to send the cannula forward over the stylet. Pet. App. C at 7a. This lever is the structure that both courts below identified as performing the required functions.

The relevant language of the asserted '797 Patent, which both parties agree is written as a means-plus-function claim, is as follows:

> A biopsy instrument comprising . . . a manually operable charging member for moving the guide to the charged position against the urging of the coil spring, and ***a release means for retaining the guide in the charged position***.

Pet. App. C at 11a (emphasis altered).

II. Proceedings Below

The district court construed the element "release means for retaining the guide in the charged position" to mean "retaining the guide in the charged position and releasing, or setting free, the guide from the charged position." Pet. App. F at 144a-48a, 150a. The court reasoned that the "release means" limitation at issue has "a very clearly defined function ('for retaining the guide in the charged position') with prefatory language ('release') that, if used to inform the recited function, would suggest a different or additional function." Pet. App. F at 148a.

On summary judgment, the district court applied the proper statutory equivalence standard and held that the accused device did not infringe the '797 Patent on the grounds that the release lever of the '797 Patent and the corresponding structure of the accused product did not perform either the releasing or the retaining function in "substantially the same way" or to produce "substantially the same result" – each of which is required under the statutory equivalence standard. Pet. App. E at 103a-108a.

A panel of the Federal Circuit Court of Appeals affirmed without dissent the district court's construction of the "release means for retaining" limitation on the grounds that since "the claim language ties both functions to the same means-plus-function element, . . . it is appropriate that the element be construed accordingly." Pet. App. C at 19a. The court also upheld the district court's application of the statutory

equivalence analysis and its grant of summary judgment of non-infringement. Pet. App. C at 20a-21a.

The panel denied Petitioner's request for panel rehearing, and all judges in active service for the Federal Circuit, after a vote, denied Petitioner's request for rehearing en banc. Pet. App. B at 4a.

REASONS FOR DENYING THE WRIT OF CERTIORARI

I. Petitioner Is Impermissibly Urging This Court to Engraft a Narrow Rule of Required Syntax on 35 U.S.C. § 112, ¶ 6.

Section 112, paragraph 6, of title 35 of the United States Code constitutes the entire statutory framework for claiming inventions in purely functional terms (*i.e.*, a means-plus-function element):

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Pet. at 7 (citing 35 U.S.C. § 112, ¶ 6).

35 U.S.C. § 112, ¶ 6 does not require specific language, format, or syntax for reciting an element; it simply requires that a patentee recite a function to be

performed by a structure without reciting the structure itself. *Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1095-96 (Fed. Cir. 2008) (stating that "means-plus-function claiming applies only to ***purely functional*** limitations") (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1311 (Fed. Cir. 2005)) (emphasis added); Pet. App. C at 19a. Settled principles of claim construction dictate whether 35 U.S.C. § 112, ¶ 6 applies to a particular element based upon how a person having ordinary skill in the art would interpret that element. This is inherently a case by case determination, as it requires analysis of the intrinsic and, at times, extrinsic evidence of record. *See, e.g., Becton Dickinson & Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1262 (Fed. Cir. 2010) (evaluating whether a claim term should be construed as a means-plus-function limitation, by beginning with the specification and intrinsic record). It does not lend itself to a universal formula or inflexible syntax.

Petitioner seeks to have this Court rule that 35 U.S.C. § 112, ¶ 6 mandates a "'means for' format with the function signaled by the preposition 'for' followed by an expressly recited function." Pet. at 10-11; Pet. at 13 (referring to it as "the statutorily-mandated means-plus-function format"). Petitioner, of course, does not draw his "statutorily-mandated" syntax from the language in 35 U.S.C. § 112, ¶ 6; it is, instead, merely an artifice for him to argue against a disappointing outcome in connection with a garden variety claim construction.

Use of the word "means" is not required at all: "When it is apparent that [an] element invokes purely functional terms, . . . the claimed element may be a means-plus-function element despite the lack of express means-plus-function language." *AI-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1318 (Fed. Cir. 1999); *TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1373 (Fed. Cir. 2008) (use of the term "means" is not the only way to invoke § 112, ¶ 6); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584 (Fed. Cir. 1996) (The "Patent and Trademark Office has rejected the argument that only the term 'means' will invoke section 112(6)."). It would defy common sense to suggest that where statutory language does not even require the use of the words "means for," it nonetheless requires a specific syntax whenever the words "means for" are used in the claim.[1]

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[1] It is highly paradoxical for Petitioner to argue that "release" is only an adjective describing the "release lever" that is a ***structure*** while, at the same time, he makes admitted use of a claiming convention that, by definition, does not describe a structure, but instead relies upon a recitation of ***function***. Pet. at 12 (arguing that the term "'release' is used as an adjective modifying the word 'lever' "); Pet. App. F at 144a (referencing Petitioner's agreement that the release element should be construed as a means-plus-function limitation).

II. This Case Presents No Break from the Long Standing and Uniform Precedent Applying 35 U.S.C. § 112, ¶ 6.

If this Court has not found reason to comment on 35 U.S.C. § 112, ¶ 6 in the fifty-eight years since its enactment, Pet. at 7 (citing *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997)), this case certainly does not present any reason for doing so now. This case involves no issue upon which opinions within or among circuits are split, or even one where there has been disagreement between appellate judges. Petitioner attempts to manufacture controversy concerning how functions are expressed in a means-plus-function limitation by forcing comparisons between the present case and those where courts clearly imported functions from sources outside of the claim. Pet. at 8-10 (citing *Micro Chem. Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250 (Fed. Cir. 1999) and *Generation II Orthotics, Inc. v. Med. Tech., Inc.*, 263 F.3d 1356 (Fed. Cir. 2001)). Not only do these cases have nothing to do with the location of the words specifying function within a claim using the word "means," but Petitioner has not – and cannot – point to a single case where any litigant has advocated successfully or unsuccessfully in favor of his interpretation of 35 U.S.C. § 112, ¶ 6.

Micro Chemical and *Generation II* do not address any proposed rule about finding the specified functions among the words used within a claim; they instead address instances where a district court impermissibly imported a description of the function

from the ***specification*** into a claim. The *Micro Chemical* court reversed a district court that had imported the phrase "sequentially and cumulatively weigh the micro ingredients" from the ***background section of the patent*** into claims reciting "weighing means for determining the weights of selected additives dispensed by said dispensing means." 194 F.3d at 1255-56; *see also Generation II*, 263 F.3d at 1364. The claim itself did not speak of sequential and cumulative weighing; the district court read them into the claim from the preferred embodiments of the invention.

Similarly, in *Generation II*, the Federal Circuit declined to find that a claim reciting "allowing controlled medial and lateral inclination of each rigid arm relative to the pivotable joint" was limited to "dynamic" control even though "the teaching of the ***specification*** impli[ed] that the 'joint means' performs only dynamic control." 263 F.3d at 1364 (emphasis added).

In marked contrast to the cases cited by Petitioner, the courts below in the case at bar dealt only with language expressed in the limitation, attempting to interpret each word of the claim that calls for "a ***release*** means for retaining the guide in the charged position." Pet. App. C at 11a (emphasis added). In accusing the courts below of having added "a second, unrecited, releasing function" (Pet. at 10),[2] or trying

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[2] A means-plus-function can certainly recite more than one function. *See, e.g., Cardiac Pacemakers, Inc. v. St. Jude Med.,*

(Continued on following page)

to add "that unrecited function to the function that *is* specified" (Pet. at 11), or impermissibly interpreting the limitation "to include a function that the 'means for' clause does not specify but that the courts below imported from elsewhere in the patent" (Pet. at 14), Petitioner presupposes that this Court will determine that the release function is "unrecited" because the word "release" precedes the word "means." There is no precedent supporting the notion that a function described before the words "means for" in a means-plus-function claim is unexpressed. And the district court's construction in this case was upheld without question or dissent.

III. While the Federal Circuit Panel's Decision Squares with Uniform Precedent, Petitioner's Mandated Syntax Rule Would Create Undesirable Consequences.

As Petitioner recognizes in his petition, 35 U.S.C. § 112, ¶ 6 was enacted to remove any doubt, after *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946), that a patentee can recite limitations using purely functional terms. Pet. at 2. In this way, it reaffirmed a broader flexibility for patentees when drafting claims. Petitioner's insistence on a limited interpretation based solely upon his view of proper syntax, on the other hand, would curb other drafter's

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Inc., 296 F.3d 1106, 1115 (Fed. Cir. 2002) (citing *Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1313 (Fed. Cir. 2001) (noting that a structure may perform two functions)).

flexibility by mandating unintended interpretations for their purely functional language placed before the word "means" without regard to the intended meaning of the claim. *See Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999) (construing "ink delivery means" to be equivalent to "means for ink delivery" because "ink delivery" was purely functional language). Further, if Congress intended only one way to draft a mean-plus-function claim, the statute would have called out the prescribed use and order of the words.

In the end, Petitioner is asking this Court to countenance a non-legislated rule that would ignore context provided by intrinsic and extrinsic evidence for each word in the claim just to drive the outcome he desires in the case at bar. This is no small consequence. Words in a claim should not be ignored simply because they lead to a limitation not present in an accused device. Courts should be encouraged to give meaning to expressed limitations that are consistent with the understanding of the person of ordinary skill in the pertinent art.

CONCLUSION

In light of the reasons set forth above, Medical Device Technologies, Inc. respectfully requests that the petition for certiorari be denied.

Dated: February 2, 2010

Respectfully submitted,

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